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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,391	04/09/2001	Louis Canuel	CAN-137	1205
27777	7590	05/18/2005		
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER CHAPMAN, GINGER T	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,391

Applicant(s)

CANUEL, LOUIS

Examiner

Ginger T Chapman

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 19 June 2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-8, 17-22, 24 and 26-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB 2,283,428 issued to Morgan.

When viewing the claimed invention the limitations drawn to test results, i.e., moisture vapor transmission rate of at least 3000-5000 g/m²/day, are being considered as product-by-process limitations. Accordingly § 2113 of the MPEP, some of which is reproduced below, dictates the manner in which the claims have been examined. Since the product can only be understood by finding the result of certain claimed characteristics, which are the result of tests, the burden of proof to overcome any rejection must be shifted to the applicant.

"The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending

Art Unit: 3761

to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983)

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

The MPEP further states that the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979)

Claims 1-3, 5-8, 26-28: As depicted in Figures 1 and 2, Morgan discloses a sanitary napkin (1) for placement in a crotch portion of an undergarment of a wearer, comprising:

- a) a liquid-absorbing section for absorbing bodily exudate (11), said liquid-absorbing section including a longitudinal axis, a front portion and a rear portion, said liquid-absorbing section including:
 - (i) a fluid-permeable cover layer (3);
 - (ii) an absorbing system underneath said fluid-permeable cover layer (11);

Art Unit: 3761

- (iii) a liquid-impervious barrier layer underneath said absorbing system (4)
- b) a breathable extension component (7) projecting from said liquid-absorbing section, said breathable extension component including a proximal edge and a distal edge spaced from said proximal edge by a distance of at least about 2.5 cm (page 3, lines 21-30), said proximal edge being united to said liquid-absorbing section (page 3, line 23);
- c) said breathable extension component being adjacent the rear portion of said liquid-absorbing section (page 3, lines 24-26);
- d) said breathable extension component having at least a portion of its extent that manifests a moisture vapor transmission rate of at least about 3000 –5000 g/m²/day;
- e) said breathable extension component (7) containing no absorbent and thus inherently having an absorption capacity that is substantially less than the absorption capacity of liquid absorbing section (11), (page 4, line 6).

Said article further having: a pair of flaps projecting from said liquid-absorbing section along generally opposite directions, each flap being adjacent to a respective longitudinal side and being capable of being folded about the crotch portion of the undergarment of the wearer when the sanitary napkin is placed in the crotch portion of the undergarment of the wearer (page 2, lines 24-28).

As to 1, Morgan at page 1, lines 8-15 states the desire to prevent leakage during nighttime use, i.e. the occurrence of nighttime failures in the rear extension of the napkin due to effects of gravity when the wearer is lying down causing menstrual liquid to travel along the body of the wearer to the buttocks area, by providing a longer napkin (page 1, line 17). Morgan, at page 4,

Art Unit: 3761

lines 14-17, expresses the desire to reduce the absorbent bulk of the napkin for increased comfort of the wearer and to minimize the amount of absorbent required for cost effectiveness.

Claim 17: sanitary napkin wherein said breathable extension component is substantially impervious to liquid (page 4, line 7).

Claim 18: wherein breathable extension component includes a layer continuous with a barrier layer of said liquid-absorbing section (page 4, line 7 and page 2, lines 14-16).

Claim 19: wherein said breathable extension component includes a liquid-permeable layer continuous with a cover layer of said liquid-absorbing section (page 4, lines 6-9).

Claim 20: wherein said breathable extension component is substantially free of absorbent material between the liquid-permeable layer and the layer continuous with the barrier layer (page 4, lines 6-9).

Claims 21 and 24: a pair of flaps (5), each flap projecting laterally from a longitudinal side of said liquid absorbent section, the flaps being capable of being folded over an edge of a crotch portion of an undergarment of the wearer, when the napkin is in use by the wearer (page 2, lines 24-26).

Claim 22: wherein said breathable extension component projects rearwardly from said liquid-absorbing section (page 3, lines 24-26).

The teachings of Morgan clearly includes the structure in claims 1, 26 and 27 but is silent as to the vapor transmission rate of the barrier layer. In the alternative, it would have been obvious to have provided a vapor transmissible material that meets the required test characteristics since applicant has not provided any most favorable material for use as the vapor

Art Unit: 3761

transmissible material or provided any proof that one of the many possible materials is required to make the invention operable.

"[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

Claims 9-12, 23, 25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan as applied to claim 1 above, and further in view of 4,536,181 issued to Cook.

Claims 9-12: The Morgan napkin includes all the structure of claims 1, 27 and 29 but is silent as to the thickness ratio of the padded absorbent and unpadded nonabsorbent sections. Cook, at column 1, lines 55-59, states the desire to provide a napkin that is sufficiently thick at the forward portion but is thin at the back portion such that it is thin and unobtrusive while providing protection against leakage during sleeping hours (col. 2, line 7-8). Referring to Figure 9, Cook teaches a sanitary napkin having a forward section (28) that has the same thickness of a

Art Unit: 3761

conventional sanitary napkin (col. 3, lines 57-59) and a rearward portion (29) decreasing in thickness to a shield that is thin and not apparent under tight-fitting outer garments (col. 4, lines 36-38) and fits smoothly within the wearers undergarment (col. 3, line 49). Cook teaches that it is known to use sanitary shields to produce a napkin that is not bulky and thus more comfortable to the wearer. In view of this known teaching, to have produced the rearward extension of Morgan with the shield thickness as taught by Cook would have been obvious to one having ordinary skill in the art at the time the invention was made.

Claims 23, 25 and 29: Morgan discloses a rearward extension but fails to teach segments projecting laterally relative the longitudinal axis of the liquid absorbing section. Cook, at column 3, lines 44-46, states the desire to provide protection against rearward leakage while the wearer is sleeping. Figure 9 clearly includes the structure of claims 23, 25 and 29, Cook teaches napkins having rearward segments projecting laterally outward (col. 4, lines 27-29) relative the longitudinal axis of the liquid absorbing section (28). Cook teaches that it is known to provide protection against leakage during sleeping by providing a rearward portion having greater lateral or transverse width than the width of the forward portion. In view of this known teaching, to have provided the rearward extension of Morgan with the laterally projecting portions as taught by Cook would have been obvious to one having ordinary skill in the art at the time the invention was made.

Claims 4 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan as applied to claim 1 above, and further in view of US 5,197,959 issued to Buell.

Morgan teaches the structure of the claimed invention but does not expressly disclose the lateral flexibility of the sanitary napkin. Buell, at col. 21, lines 25-41 states the desire to prevent

Art Unit: 3761

rearward leakage along the gluteal groove while the wearer is sleeping by enhancing the ability of the back section to conform to the anatomy of the gluteal groove. Buell teaches a napkin having sections which overlie the vaginal opening and gluteal groove respectively, and having V or U shaped sections for disposal in the wearer's gluteal groove wherein the shaped section includes a longitudinally extending preferential bending zone to impart lateral flexibility thus enhancing the formation of the shape (fig. 6, 7 and 19; see also col. 20, lines 67-68, to col. 21, lines 1-41). In view of this known teaching, to have provided the longitudinally extending preferential bending zones to enhance lateral flexibility as taught by Buell on the liquid absorbing and rearward extending portions of Morgan would have been obvious to one having ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant's arguments, see page 5, filed 13 May 2003, with respect to the rejection of claims 1-29 under provisional obviousness-type double patenting over claims 1-29 of co-pending application 09/570,113, now expressly abandoned, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejection are made in view of newly found prior art references as detailed *supra*.

It is noted in applicant remarks that applicant submits that co-pending application 09/440,113 has been expressly abandoned; 09/440,113 is now issued 6,709,653. Examiner considers this a typographical error as the provisional double patenting rejection was directed to co-pending application 09/570,113, which is now expressly abandoned.

Art Unit: 3761

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Examiner notes Application No. 10/289,293, filed Nov. 6, 2002 now PG Publication US 2003/012023 A1 publication date June 26, 2003 listing different inventive entity Boulanger and commonly assigned. Examiner notes Figures 1-10 clearly depict structure substantially identical to instant application. Both applications disclose a sanitary napkin which has lateral flexibility and extends into the gluteal groove having a nonabsorbent rearward extension (24) defined in terms of a liquid-arresting section in 10/289,293 and in terms of a breathable extension in 09/829,391. Considering the figures in light of the specification, the examiner finds that Figures 1-10 merely depict an obvious variant of the invention already disclosed in Figures 1-10 of US Application No. 09/829,391.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3761

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T Chapman whose telephone number is (571) 272-4934.

The examiner can normally be reached on Monday through Friday 8:30 a.m. to 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ginger Chapman
Examiner, Art Unit 3761



Larry I. Schwartz
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